

REMARKS

This application contains claims 1-42. Claims 1, 19, 22 and 40 are hereby amended. No new matter has been introduced. Reconsideration is respectfully requested.

Claims 1-5, 11-26 and 32-42 were rejected under 35 U.S.C. 102(b) over Prohs et al. (U.S. Patent 5,267,305). Applicant has amended independent claims 1 and 22 so as to more clearly distinguish the present invention over the cited art, by incorporating limitations originally recited in dependent claims 19 and 40. Claims 19 and 40 have been amended to accord with the amendment to claims 1 and 22.

Prohs describes a method for transparent in-band signaling during a telephone conversation, which permits a party to a telephone conversation to signal a telecommunications system to perform desired functions without the other party hearing the signals (abstract). This method is described in the context of call centers (col. 1, lines 17-61), which may also involve subsidiary locations and call center agents working remotely from the main call center location (col. 1, lines 32-34, and col. 2, lines 57-65, as well as Fig. 2). The method permits agents to perform functions by pressing keys on their telephone, such as placing a caller on hold, or signaling a supervisor (col. 65, lines 47-54). The purpose of the transparent signaling is not to hide the agent's actions from the caller (who will clearly be aware of having been placed on hold or referred to a supervisor), but rather to avoid the irritation of "blasting [the caller] in the ear with DTMF tones" (col. 2, lines 50-52).

Claims 1 and 22, as amended, respectively recite a system and a method that enable a participant in a telephone conversation to request, during the conversation, that the conversation be recorded. At least one of the other participants receives no indication of the request. As noted in the specification (page 2, lines 2-11), this capability satisfies a long-felt need to permit telephone users to begin recording a conversation in cases in which the importance of making the recording becomes apparent only during the conversation. The desire to record the conversation may be due to the identity of the other participant or the nature of the conversation, for example. In such cases, if the other participant were to become aware that the conversation was being recorded, the whole purpose of the recording could be defeated.

The need recognized by the inventor in the present case is not addressed by the prior art. Although Prohs mentions many types of "records" that are kept by his system, he neither teaches nor suggests the possibility that his signaling methods might be used to initiate a remote recording of the conversation, as required by claims 1 and 22. As noted above, Prohs is not concerned with hiding the results of the signaling from either party to the telephone conversation, but simply with avoiding auditory unpleasantness. Therefore, Prohs provides no motivation that would have led a person of ordinary skill in the art to use his signaling method for purposes of initiating a recording without knowledge of at least one of the call participants.

Thus, amended independent claims 1 and 22 are believed to be patentable over the cited art. In view of the patentability of claims 1 and 22,

dependent claims 2-5, 11-21, 23-26 and 32-42 are believed to be patentable, as well.

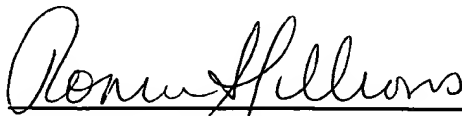
Claims 6-9 and 27-30 were rejected under 35 U.S.C. 103(a) over Prohs in view of Wrede et al. (U.S. Patent 5,937,040), while claims 10 and 31 were rejected under 35 U.S.C. 103(a) over Prohs in view of Wrede and further in view of Regnier (U.S. Patent 6,345,047). In view of the patentability of amended claims 1 and 22, from which claims 6-10 and 27-31 depend, Applicant believes these dependent claims to be patentable, as well.

Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, Applicant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

If the Examiner has any questions he is invited to contact the undersigned at 202-628-5197.

Respectfully submitted,

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